

### **REMARKS**

In response to the Office Action of June 27, 2006, Applicants have carefully considered the rejections of the Examiner in the above-identified application. In light of this consideration, Applicants believe that the claims remain allowable. Applicants respectfully request reconsideration of the rejection of the claims now pending in the application.

In this the first office action the specification is objected to for informalities. Claims 4, 10 and 18 are objected to for informalities. Claims 1-20 are provisionally rejected under the doctrine of double patenting. Claims 1-10, and 14-20 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,351,621 to Richards et al. (hereinafter Richards). Claims 11-13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Richards in view of U.S. Patent No. 6,735,399 to Tabb et al. (hereinafter Tabb).

The specification and claims 4, 10 and 18 are objected to for informalities. The specification has been amended as is provided above and these changes are believed as bringing into compliance the objections as to informalities.

Claims 1-20 are provisionally rejected under the doctrine of double patenting as being unpatentable over copending Application No. 10/447,737 "Machine Post-launch Configuration And Option Upgrade" filed 5/29/03 and copending Application No.10/630,076, "Machine Post-launch Configuration And Option Upgrade With Master Key" filed 7/30/2003. A terminal disclaimer is hereby attached.

Claims 1-10, and 14-20 are rejected under 35 U.S.C. §102(b) as being anticipated by Richards. The Applicants must respectfully traverse. The Richards reference is not unknown to the Applicants, assigned as it is to the Xerox Corporation, just like the present application. Indeed the Applicants go to some trouble to acknowledge Richards, citing Richards on page 3, lines 24-33 of their specification.

Richards teaches that in a printer or copier, a removable module, such as a marking material supply module or a marking device module, is provided with a non-volatile memory chip which retains information about the cumulative use of the module and other performance-related data. The non-volatile memory is accessed through a wireless interface, such as an RF loop or IR detector, which is also associated with the module. The memory can be accessed, through wireless means, either by the printer or copier itself or by an external device.

So yes, Richard teaches about a non-volatile memory chip which is accessed through a wireless interface. However, Richards does not teach:

*reading via the wireless interface the programmable serial region of the memory **and if found blank**, initializing with a machine identification number;*

***comparing** the content of the programmable serial region **if not blank** with the machine identification number;*

A §102 “anticipation” rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claim. That is, §102 anticipation requires that all of the elements and limitations of the claim are found within a single prior art reference. That is the unequivocal current and controlling view of the Federal Circuit. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983); Atlas Powder v. E. I. DuPont, 750 F. 2d 1569, 224 U.S.P.Q. 409 (Fed. Cir. 1984); Jamesbury Corp. v. Litton Industrial Products, 756 F.2d 1556, 225 U.S.P.Q. 253 (Fed. Cir. 1985); Carella v. Starlight Archery and Pro Line Co., 804 F.2d 135, 138, 231 U.S.P.Q. 644, 646 (Fed. Cir. 1986); and Davis v. Loesch, 27 U.S.P.Q. 2d 1440, 1445 (Fed. Cir. 1993), citing Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir.), cert. denied, 493 U.S. 853 (1989), “The identical invention must be shown in as complete detail as contained in the ... claim.”

Thus for a §102 “anticipation” rejection against a method claim the prior citation must provide the same steps with the same interdependent

relationships. So while Richards may employ some of the same operations and functions, it does not teach the Applicant's claimed methodology to provide a operations key as explained in the application specification. The Applicants' claims are written for one skilled in the art and as such no term therein is to be ignored. As the Court of Appeals for the Federal Circuit has stated, although the differences between the claimed invention and the prior art may seem slight, those differences may also have been the key to the advancement of the art. Reference, for example, Jones v. Hardy, 220 U.S.P.Q. 1021 (Fed. Cir. 1984). Allowance of claims 1-10, and 14-20 is respectfully requested.

Claims 11-13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Richards in view of Tabb. These are dependent claims and since they depend upon claims deemed allowable they should be allowed as well. Please note as to the applied Tabb reference (U.S. Patent No. 6,735,399) the present application was filed on 7/30/2003. That date is after the 11/29/00 effective date of the amendment of 35 U.S.C. §103(c) which eliminated §102(e)/103 rejections against subject applications filed or refiled after that date. This reference and the present application are commonly owned (on their face, and of record).

The undersigned patent attorney hereby provides the simple statement that MPEP §706.02(L)(2) states is all that is necessary to remove such a 35 USC §103(c) reference. Namely, that: *"the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person."* [35 USC §103(c) enacts the sound principle that an assignee's *own secret, unpublished, pending* applications on its own research cannot be used against its own research improvement applications filed thereon before publication of the reference.] Allowance of claims 11-13 is respectfully requested.

No additional fee is believed to be required for this amendment; however, the undersigned Xerox Corporation attorney authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025.

It is respectfully submitted that the present set of claims, as amended, are patentably distinct over the cited references. In the event the Examiner considers personal contact advantageous to the disposition of this case, he is hereby requested to call the undersigned attorney at (585) 423-6918, Rochester, NY.

Respectfully submitted,

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